



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,564	03/28/2001	Edward O. Clapper	10559-360001 / P10037	9279

20985 7590 02/04/2004

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

MWANYOHA, SADIKI P

ART UNIT PAPER NUMBER

2642

DATE MAILED: 02/04/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,564

Applicant(s)

CLAPPER ET AL.

Examiner

Sadiki Mwanyoha

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment dated December 2, 2003 was received and entered.

Drawings

2. The drawing corrections submitted December 2, 2003 are objected to because the numbers and reference characters are not plain and legible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-6 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant may note that these claims depend on claims that have been canceled per Applicant's amendment. Examiner will assume that claims 5 and 6 depend on claim 1 and that claims 12 and 13 depend on claim 8.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2642

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,088,362 to Turnbull et al.

Regarding claim 1, Turnbull et al. discloses a “Key telephone system without common control”. The invention of Turnbull et al. comprises establishing one station as a communications session master (i.e. from a first telephone) by seizing the line preparatory to calling one of the other stations, transmitting an out-of-band data signal (i.e. signalling a request for a call feature) to acquire inter-station synchronization with a called slave station [see Turnbull et al. col. 3, line 1]. The invention of Turnbull operates over a two-wire transmission line (i.e. over a phone line) [see Turnbull et al. col. 3, line 20]. Furthermore, the slave station responds to the signal by sending back a synchronization pulse and adjusting its native master time clock to conform to the timing of the master station (i.e. processing the request in a processing element which is separate and remote from said first telephone). Any one of the stations (14) in the system (10) may be either a master or slave depending upon which station seizes (i.e. which signaled the request) the line (i.e. by automatically setting said first telephone which signalled the request as a master controller which can send commands and all remaining phones as slaves which receive commands from the master) [see Turnbull et al. col. 6, line 25]. Signaling data is sent over a signaling channel (i.e. transmitting instructions from the master to the slaves, in response to the request to command extensions over the phone line[s]) [see Turnbull et al. col. 7, line 60].

Art Unit: 2642

Regarding claim 3, further note that the invention of Turnbull et al. comprises a signaling channel above the voice-band (i.e. at a frequency not used for voice or voice-over-data communications) [see Turnbull et al. col. 5, line 55]. Signaling is therefore out-of-band and does not interfere with voice intercom.

Claim 8 is substantially similar in subject matter to claim 3 and therefore, rejected under the same rationale.

Claim Rejections - 35 USC § 103

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. As shown above, Turnbull et al. teaches the method of claim 1. However, Turnbull et al. does not teach automatically resetting assignment of master and slave by the phone system after a predetermined time of inactivity.

Nevertheless, this feature is implied by the invention of Turnbull et al., since any one of the stations in the system may be either master or slave, depending on which station seizes the line [see Turnbull et al. col. 6, line 25]. This would imply that once a user finishes using a phone as master (i.e. after a predetermined time of activity), the phone would relinquish its master assignment, so that another phone may seize the line and assume master status. Obviously, a station will not remain a master indefinitely.

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Armstrong.

Art Unit: 2642

Regarding claim 5, as shown above, Turnbull et al. does teach the method of claim 1.

However, Turnbull et al. does not teach paging a slave phone from the master phone.

Nevertheless, Armstrong discloses an “intercom system”. According to the invention of Armstrong, anyone of the master control station (100) (i.e. from the master phone), the inside stations (106,108,110,112,114) (i.e. slave phone), and outside stations (120,122,124) (i.e. slave phone) may be used to page all the other stations (i.e. slave phone) [see Armstrong col. 3, line 14]. That is, the invention of Armstrong discloses a master control station (i.e. master phone) paging an inside remote control station (112) (i.e. slave phone), for example (i.e. paging a slave phone from the master phone).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the method of Turnbull et al. to include the high priority (i.e. from the master phone) being operable for paging a lower priority (i.e. slave phone) as taught by Armstrong, because paging is a standard phone feature in shared line environments.

Regarding claim 13, as shown above, Turnbull et al. does teach the method of claim 8.

However, Turnbull et al. does not teach paging a slave phone from the master phone.

Nevertheless, it would have been obvious for the above reasons.

9. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Lee.

Regarding claim 7, as shown above, Turnbull et al. does teach the method of claim 1.

However, Turnbull et al. does not teach placing one of the phone lines on hold.

Nevertheless, Lee discloses a “single-line telephone hold circuit”. The invention of Turnbull et al. relates to an interface device for use in a residential telephone subscriber line to place a temporary hold on a subscriber’s telephone line. The invention of Lee comprises a master unit (i.e. one of the phone lines) in room A, and two remote units in rooms B and C. According to the invention of Lee, the master unit may activate a hold if the subscriber wishes to leave room A (i.e. placing one of the phone lines on hold). Furthermore, if the hold was activated from the master unit, the subscriber may subsequently remove the hold from any of the locations A, B or C [see Lee col. 4, line 31].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Turnbull et al. such that a high priority endpoint (i.e. master phone) could be placed on hold, as taught by Lee, because such a feature provides user mobility by allowing a user stationed at a high priority endpoint, for example, to move to a new location containing a low priority endpoint, while still maintaining the current call.

Regarding claim 12, further note that the master station taught by Turnbull et al. in view of Lee reads on master phone (i.e. placing the master phone on hold).

10. Claims 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Bleile et al.

Regarding claim 10, as shown above, Turnbull et al. teaches the method of claim 8. However, Turnbull et al. does not teach transmitting a call waiting request to the master phone if any slave phone is activated.

Nevertheless, Bleile et al. discloses “coordinating telephones or adjuncts on the same loop”. The invention of Bleile et al. relates to Spontaneous Call Waiting InDication (SCWID). According to the invention of Bleile et al., a flash master (i.e. the master phone) may be connected (i.e. conferencing) with a flash slave (i.e. a slave phone) in response to a call waiting indication transmitted by the flash slave (i.e. transmitting a call waiting request to the master phone if any slave phone is activated) [see Bleile et al. col. 6, line 50].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the method of Turnbull et al. by transmitting a call waiting request to the master (as taught by Bleile et al.), because such a feature would enable slave phones to notify a master phone currently in use, in the case of an emergency or some other critical event.

Regarding claim 11, further note that in response to the call waiting indication, the flash master is connected to the flash slave (i.e. conferencing a slave phone with the master phone in response to the call waiting request).

Regarding claim 6, as shown above, Turnbull et al. teaches the method of claim 1. Furthermore, it was just shown that Bleile et al. teaches conferencing a slave phone with the master phone.

11. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholet et al. in view of Turnbull et al.

Regarding claim 14, Bartholet et al. discloses a “distributed telephone system”. Referring to Bartholet et al. Fig. 1, telephones (52) (i.e. plurality of extensions) are connected to the system via control units (54) (i.e. controller), which are responsible for controlling the

Art Unit: 2642

switching and routing of communication between a telephone and other telephones of the system (i.e. from a plurality of phone extensions). Both conversation and control signals are communicated via coaxial cable (56) (i.e. over a phone line) via a set of narrow bandwidth channels [see Bartholet et al. col. 2, line 60]. In response to a request to initiate telephonic communications (i.e. receives requests for call features), the control unit (54) comprises a microcomputer (15) that selects one of the channels in accordance with a pre-established protocol (i.e. the controller processes the requests) [see Bartholet et al. col. 3, line 29]. Furthermore, the microcomputer (15) also transmits a control word (i.e. transmits instructions) to all control units (54) of the system (i.e. to the phone extensions based on the requests). Moreover, the control unit (54) comprises two transmitters and two receivers. One of the transmitters and one of the receivers (i.e. a first tranceiver) are used for transmission and reception of control signals (i.e. provides communications) generated by the control units (54) (i.e. between the controller and the phone extensions) for the switching and routing of the telephone signals on the narrow bandwidth channels [see Bartholet et al. col. 3, line 15]. However, Bartholet et al. does not teach and which automatically designates a last phone to make a request as a master phone, that can send requests to all other phones, and which other phones are designated as slave phones.

Nevertheless, note that last phone reads on the master phone responsible for seizing the line according to the invention of Turnbull et al. (i.e. and which automatically designates a last phone to make a request as a master phone, that can send requests to all other phones). Also, recall that according to the invention of Turnbull et al., the phones comprise a plurality of

Art Unit: 2642

stations in which there is a single master phone, along with multiple slave phones (i.e. and which other phones are designated as slave phones).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the master-slave paradigm as presented by Turnbull et al., because it is well-known in the art as a way to arbitrate contention for channel resources.

Regarding claim 15, further note that according to the invention of Bartholet et al., the second transmitter and second receiver (i.e. a second transceiver) are used for the transmission and reception of narrow band telephone signals for voice and data communications (i.e. used for voice communications) [see Bartholet et al. col. 3, line 11].

Regarding claim 16, further note in reference to Bartholet et al. Fig. 7, that the first transmitter and first receiver (i.e. the first transceiver) disclosed by Bartholet et al. uses the control data channel, which comprises a different frequency band (i.e. operates at a different frequency) than the voice channel used by the second transmitter and second receiver (i.e. than the second transceiver) disclosed by Bartholet et al.

Regarding claims 17-20, further note that the invention of Bartholet et al. provides full PBX functions (i.e. call features) including call waiting, conference calling, intercom (i.e. paging), and hold (i.e. call hold), respectively [see Bartholet et al. col. 11, line 60].

Regarding claim 21, further note that each control unit (54) can be employed (i.e. call features are accessed through) with a telephone handset (i.e. phone handsets) [see Bartholet et al. col. 3, line 5].

Regarding claim 22, further note that each control unit (54) shown in Bartholet et al. Fig. 1 is assigned a nominal "home line" preferably corresponding to an extension number (i.e.

Art Unit: 2642


connected to at least one phone extension) [see Bartholet et al. col. 12, line 3]. Furthermore, the control unit (54) comprises a keyboard or keypad (14) (i.e. control center) used by the sender party (i.e. user) to enter the number for the target party, which is to be called (i.e. provides a user interface to access the call features) [see Bartholet et al. col. 5, line 66].

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sadiki Mwanyoha whose telephone number is 703-305-3417. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

spm


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600